

MENOZZI et al  
Serial No.: 09/192,579  
September 22, 2003

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested.

Claims 56-67 remain rejected under 35 USC 102(b) as being anticipated by Menozzi et al. The rejection is again traversed.

It is now well settled that prior art under 35 USC 102(b) must describe the claimed invention sufficiently to have placed the public in possession of that invention. Possession is effected if one skilled in the relevant art could have combined the publication's description of the invention with his/her own knowledge to make the claimed invention. Thus, even if a claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling. *In re Donohue, 226 USPQ 619, 621 (Fed. Cir. 1985).*

In the case of the present invention, the art upon which the Examiner relies is clearly not enabling. As pointed out, for example, in the Amendment filed January 10, 2003, the citation does not contain information so as to permit molecular characterization of the functional activity, i.e., the heparin-binding properties and/or the capability of

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sulfated polysaccharides to inhibit erythrocyte agglutination by 28 kDa purified heparin-sepharose chromatography fraction. No amino acid sequence is provided and the monoclonal antibodies used are neither defined nor characterized. Thus, one skilled in the art could not have combined the publication's description with his/her own knowledge to have made the claimed invention. For this reason alone, the rejection must fail.

The Examiner contends that the amino acid sequence of the claims would have been inherent in the teachings of the reference. This assertion overlooks the fact that, as noted above, the citation is non-enabling.

Further, the Examiner is reminded that to anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.

*In re Schreiber*, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Inherency, may not be established by probabilities or possibilities. The fact that a certain thing may result from a given set of circumstances is not sufficient. Only if the prior art necessarily functions in accordance with, or includes, the claimed limitations, does it anticipate.

See *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986).

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Here, the Examiner has not properly supported his position that the sequence of the material of the reference is necessarily identical to that of the claims - certainly, the name, molecular weight, etc., referenced on page 3 of the Action does not constitute the requisite support.

In view of the above, reconsideration and withdrawal of the rejection are again requested.

This application is submitted to be in condition for allowance and a Notice to that effect is requested.

Respectfully submitted,

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